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EXAMINER

SHECHTMAN, CHERYL MARIA

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--|--|--|
| Office Action Summary | Application No. 10/529,541 | Applicant(s) SUMIZAWA ET AL. | |
| | Examiner CHERYL M. SHECHTMAN | Art Unit 2169 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 14-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 14-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/29/05, 2/17/06, 6/12/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to Preliminary amendment filed March 29, 2005. Claims 1-11 and 14-22 are pending. Claims 5, 6, and 8-11 are amended. Claims 12 and 13 are cancelled. Claims 14-22 are newly added.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

3. The information disclosure statement filed March 29, 2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Objections

4. Claims 1, 2, 4, 6, and 7 are objected to for the following grammatical informalities:

- Claims 1 and 6: the limitation "road data set" in para. 2 of the claims should read "a road data set";

Art Unit: 2169

- Claims 2, 4 and 7: the limitation "the distribution map data include the road data" in para. 2 of the claims should read "the distribution map data *includes* the road data";

5. Claim 18 is objected to because of the following informalities: the claim depends from cancelled claim 13. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Referring to claim 1, the claim recites the limitation "the plurality of map area blocks" in para. 3 of the claim. However, it is unclear as to whether the recited map area blocks are meant to refer to the specific map area blocks.

Referring to claim 3, the claim recites the limitation "road data set" in para. 2 of the claim. However, it is unclear as to whether the road data in the road data set is meant to refer to the extracted road data previously recited in the claim.

Art Unit: 2169

Referring to claim 3, the claim recites the limitations “each of specific map area blocks”, “each of the map area blocks” and “the map area block” in para. 2 of the claim. However, it is unclear as to whether the map area block(s) are meant to refer to the plurality (or one) of map area blocks previously recited in the claim.

Claims 3 and 6 recite the following limitation: "the map area block and name data set", in para. 2 of the claims. There is insufficient antecedent basis for this limitation in the claims.

Referring to claim 3, the claim recites the limitation “a plurality of map area blocks” in para. 3 of the claim. However, it is unclear as to which of the many recitations of the “plurality of map area blocks” is being referenced.

Claims 5 and 14 recite the following limitation: "the route", in para. 2 of the claims. There is insufficient antecedent basis for this limitation in the claims.

Referring to claim 5, the claim recites the limitations “the map area block” in para. 2 of the claim, “a plurality of map area blocks” in para. 3 of the claim, and “individual map area blocks” in para. 4 of the claim. However, it is unclear as to whether the map area block(s) are meant to refer to the specific map area blocks previously recited in the claim.

Claims 9, 16, 17, and 18 recite the following limitation: "the integrated name data in the received distribution map data", in para. 3 of the claims. There is insufficient antecedent basis for this limitation in the claims.

Claims 11 and 22 recite the following limitation: "the names paralleled to inclinations of the route", in para. 2 of the claims. There is insufficient antecedent basis for this limitation in the claims.

Due to the 35 USC § 112 rejections, the claims have been examined as best understood by the examiner.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1 and 2 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Referring to claim 1, the claim recites a computer product having stored therein distribution map data. However, the claim discloses software per se since it lacks the hardware necessary to realize any underlying functionality. Examiner suggests that the preamble of the claims be rephrased so as to enable the computer program to be tangibly embodied in a computer readable storage medium in order to make the claims describe statutory subject matter.

To expedite a complete examination of the instant application, the claims

Art Unit: 2169

rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of the invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

17. Claims 1-11 and 14-22 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent Number 6,067,499 issued to Yagyu et al (hereafter Yagyu), as disclosed by Applicant.

Referring to claim 1, Yagyu discloses a computer product having stored therein distribution map data used to distribute a map through communication, the distribution map data comprising (Abstract; 'detailed road system data', Fig. 2, element 21; col. 6, line 66 – col. 7, line 17):

- road data set in correspondence to each of specific map area blocks to provide position information indicating positions of roads within the map area blocks (different map regions contain position information stored within the position detection data storage unit 1, see Fig. 2, Fig. 8A-D and corresponding portions of specification; col. 8, lines 12-24; see also col. 6, line 66 – col. 7, line 8); and

Art Unit: 2169

- integrated name data each set of which provides common name information for a road passing through a plurality of map area blocks in common with the plurality of map area blocks (passage link table stores integrated route selection data of all map regions in route selection data storage unit 4, the integrated data also pertains to common road names of links in the map, see Fig. 7A-C, Fig. 8A-D and corresponding portions of specification; col. 2, lines 8-27; col. 8, line 31 – col. 9, line 29; Fig. 13, element (E) and corresponding portions of specification).

Referring to claim 3, Yagyu discloses a distribution map data generating method for generating distribution map data used to distribute a map through communication (Abstract; 'detailed road system data', Fig. 2, element 21; col. 6, line 66 – col. 7, line 17; see Summary of Invention), comprising:

- extracting road data and name data over a plurality of map area blocks to indicate a route passing through the plurality of map area blocks, from road map data that includes road data set in correspondence to each of specific map area blocks to provide position information indicating positions of roads in the map area block (different map regions that contain *position information* stored within the position detection data storage unit 1, see Fig. 2, Fig. 8A-D and corresponding portions of specification; col. 8, lines 12-24; see also col. 6, line 66 – col. 7, line 8) and name data set in correspondence to each of the map area blocks to provide name information indicating names of the roads in the map area block (*place names*, col. 8, lines 25-30; *road names*, col. 22, lines 21-50);

Art Unit: 2169

- generating integrated name data by integrating name information in the extracted name data, which is set in correspondence to a plurality of map area blocks to indicate a single road, so as to provide common name information for indicating name of a road in common with the plurality of map area blocks (passage link table stores integrated route selection data of all map regions in route selection data storage unit 4, the integrated data also pertains to common road names of links in the map, see Fig. 7A-C, Fig. 8A-D and corresponding portions of specification; col. 2, lines 8-27; col. 8, line 31 – col. 9, line 29; Fig. 13, element (E) and corresponding portions of specification); and
- generating the distribution map data by using the extracted road data and the integrated name data (col. 8, lines 25-30; Fig. 25A-B and related portions of specification; Fig. 29A-B and related portions of specification).

Referring to claim 6, the claim is similar to claim 3 in the form of an apparatus (Yagyu, Abstract; see Summary of Invention) and is hereby rejected for the same reasons as claim 3 addressed above.

Referring to claims 2, 4, and 7, Yagyu discloses that the distribution map data includes the road data in each of a plurality of map layers set in correspondence to different specific scaling factors (col. 10, lines 1-7; Fig. 15 A-B, col. 15, line 50 - col. 16, line 4; Fig. 24A-B, col. 21, line 63 - col. 22, line 20) and each set of the integrated name data provides the common name information for a road in common with the plurality of

Art Unit: 2169

map layers as well (passage link table stores integrated data which pertains to common road names of links in the map, see Fig. 7A-C, Fig. 8A-D and corresponding portions of specification; col. 2, lines 8-27; col. 8, line 31 – col. 9, line 29; Fig. 13, element (E) and corresponding portions of specification).

Referring to claims 5, 8, 14, and 15, Yagyu discloses that the route is determined as a road from a start point to an end point based upon the road data; and when extracting the road data and the name data indicating the route, road data and name data contained in an area ranging over a predetermined width along the route are extracted based upon the road map data (Fig. 19A-D and related portions of specification; Fig. 21 and related portions of specification).

Referring to claims 9, 16-18, Yagyu discloses a reception device that receives the distribution map transmitted from an external source (traffic information input unit 3, Fig. 1 and related portions of specification); and a display device that displays at least part of a route on a monitor based upon road data in the received distribution map data and displays names of roads attached to the roads on the route based upon the integrated name data in the received distribution map data (output data generation and output units 8 and 9 and related portions of specification; see also Fig. 8C-D, Fig. 25A and related portions of specification).

Referring to claims 10, 19-21, Yagyu discloses a first position determining device that determines display positions at which the names of the roads on the route are displayed by the display device based on the road types of the roads on the route (Fig. 25A and related portions of specification).

Referring to claims 11 and 22, Yagyu discloses a second position determining device that determines display positions at which the names of the roads on the route are displayed by the display device so as to orient the names paralleled to inclinations of the route (see Fig. 13 and related portions of specification).

Conclusion

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents or publications are cited with respect to delivering road map data and determining road overlap:

- US Patent 6,658,351 issued to Seto et al.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl M Shechtman who can be reached on (571) 272-4018. The examiner can normally be reached on 9:00 am - 5:30 pm.

Art Unit: 2169

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trujillo can be reached on (571) 272-3677. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Cheryl M Shechtman/

Examiner, Art Unit 2169

/Wilson Lee/

Primary Examiner, Art Unit 2163

October 9, 2008